REMARKS

Claims 1-24 were pending in this application.

Claims 1-22 have been rejected.

Claims 23 and 24 have been objected to.

Claims 6, 11, 12, 18, 19, 23, and 24 have been amended as shown above.

Claims 1-24 remain pending in this application.

Reconsideration and full allowance of Claims 1-24 are respectfully requested.

I.   OBJECTIONS TO CLAIMS

The Office Action objects to Claims 23 and 24 as being improper dependent claims. In particular, the Office Action objects to Claims 23 and 24 as failing to further limit the subject matter of a previous claim.

The Applicant has amended Claim 23 to correct an improper claim dependency. Claim 23 now depends from Claim 22. Claim 24 has also been amended to depend from Claim 22. The Applicant respectfully submits that Claims 23 and 24 both further limit the subject matter of a previous claim.

Accordingly, the Applicant respectfully requests withdrawal of the objections to the claims.

II.   REJECTION UNDER 35 U.S.C. § 101

The Office Action rejects Claims 19-22 under 35 U.S.C. § 101 as being directed to non-

statutory subject matter. The Applicant has amended Claim 19 to recite a "plurality of data packets stored on a computer readable storage medium." The Applicant respectfully submits that Claim 19 as amended recites patentable subject matter and does not merely recite a video format.

Accordingly, the Applicant respectfully requests withdrawal of the § 101 rejection.

III. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,734,862 to Kulas ("*Kulas*") in view of U.S. Patent No. 6,438,319 to Inoue et al. ("*Inoue*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226*

U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993))*. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP § 2142*).

Regarding Claim 1, the Office Action asserts that *Kulas* discloses a "first data packet" having "location information identifying a storage address of a second data packet" at column 13, lines 17-19. (*Office Action, Page 3, First paragraph*). However, the cited portion of *Kulas* describes a buffer that contains slots, where each slot is capable of storing "a frame of data along with any associated information." (*Col. 12, Line 59 – Col. 13, Line 1*). The cited portion of *Kulas* specifically recites that each slot in a "linked list of slots" includes a "pointer to the next slot in the list." (*Col. 13, Lines 13-16*).

This portion of *Kulas* simply recites that each slot in a buffer includes a pointer to another slot in the buffer. This portion of *Kulas* lacks any mention of a "first data packet" that identifies the storage address of a "second data packet" as recited in Claim 1. In particular, this portion of

Kulas lacks any mention of a "first data packet" that includes "header information," where the header information includes "location information identifying a storage address of a second data packet" as recited in Claim 1.

Moreover, Claim 1 recites that the "first data packet" is associated with a "first Intra frame" and that the "second data packet" is associated with a "second Intra frame." The Office Action fails to establish that the "frame" in one slot of the buffer of *Kulas* points to another "frame" in another slot of the buffer, where both "frames" are "Intra frames." In fact, the Office Action cannot make this showing. The buffer appears to store consecutive frames from a "data path." (*Col. 13, Lines 26-65*). *Kulas* also expressly states that intra frames generally represent "one of every 12 frames in a sequence." (*Col. 16, Lines 28-31*). Based on this, the Office Action cannot establish that two consecutive frames in the buffer of *Kulas* are "Intra frames," where a "first data packet" associated with the "first Intra frame" includes location information identifying the storage address of a "second data packet" associated with a "second Intra frame" as recited in Claim 1.

The Office Action also acknowledges that *Kulas* fails to disclose a device that "modifies header information" in a first data packet to include location information identifying a storage address of a second data packet. (*Office Action, Page 3, First paragraph*). The Office Action then asserts that *Inoue* discloses these elements of Claim 1 and that it would be obvious to combine *Kulas* and *Inoue*. (*Office Action, Page 3, First paragraph*).

The Office Action cites one portion of *Inoue* (column 5, lines 43-48) as disclosing these elements of Claim 1. However, the cited portion of *Inoue* simply recites that a "copyright field"

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in the header of a data packet may be modified to prevent the contents of the data packet from being copied more than an allowable number of times. (*Col. 5, Lines 40-48*). This portion of *Inoue* contains absolutely no mention of modifying the header of a data packet to include "location information" identifying the "storage location" of another packet as recited in Claim 1.

For these reasons, the Office Action fails to establish that the proposed *Kulas-Inoue* combination discloses, teaches, or suggests all elements of Claim 1. For similar reasons, the Office Action fails to establish that the proposed *Kulas-Inoue* combination discloses, teaches, or suggests analogous elements of Claims 7, 13, and 19. As a result, the Office Action has not established a *prima facie* case of obviousness against Claims 1, 7, 13, and 19 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 1-22.

IV.   CONCLUSION

The Applicant respectfully asserts that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _July 6, 2005_

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